

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

104402.00119

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed

Name _____

Application Number:

09/741,219

Filed: December 19, 2000

First Named Inventor:

Adam BOSWORTH

Art Unit: 2193

Examiner: Tuan A. Vu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

_____/Michael A. Leonard II/

Signature

☐ Applicant/Inventor.☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

_____/Michael A. Leonard II

Typed or printed name

☒ Attorney or agent of record.Registration No. 60,180

_____/703-720-7883

Telephone number

☐ Attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34 _____

_____/September 23, 2009

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 7676

Adam BOSWORTH et al.

Art Unit: 2193

Application No.: 09/741,219

Examiner: Tuan A. Vu

Filed: December 19, 2000

Attorney Dkt. No.: 104402.00119

For: CELL BASED DATA PROCESSING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 23, 2009

Sir:

Appellants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-21 and 25 in the above identified application. Claims 1-21 and 25 were finally rejected in the Office Action dated July 14, 2009.

The Office Action Clearly Failed to Make a *Prima Facie* Case of Obviousness and the Office Action is Further not Complete as to All Matters

The Office Action failed to make a *prima facie* case of obviousness under MPEP §§ 2142 and 2143 and further is not complete as to all matters as required by 37 C.F.R. § 1.104(b). Appellants respectfully submit that this constitutes clear error in the Office Action.

With respect to the rejection of claims 1-21 and 25 under 35 U.S.C. § 103(a), the claimed features were essentially copied into the Office Action with citations and one or more terms appended to certain parts thereof, either without providing any reasoning or without matching the specific claimed features and portions of the cited art. For instance, in rejecting "receiving at execution time, a data processing specification having a first and a second data processing cell specification; specifying a first and a second data processing cell respectively, with each data processing cell specification having a plurality of statements including a formula specifying an action or computation", the Office Action merely provided the statement "(e.g. *template match* - sec 7.1, pg. 28, 32; sec 7.6, pg. 35-36)". Similar problems are present at least with respect to the rejections of the "analyzing" and "generating" features. For these features, the Office Action has not stated what discussion within the cited sections of "W3C", which apparently comprises two different documents (of which only one appears to be used), is

alleged to correspond with each claimed feature. In view of these and other shortcomings, Appellants respectfully submit that the Office Action has not made a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

As stated in MPEP § 2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” “With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not” (*Id.*). “The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation** of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made **explicit**” (MPEP § 2143, emphasis added). Further, MPEP § 2143.03 adds that, “**All words** in a claim must be considered in judging the patentability of that claim against the prior art” (emphasis added).

While citations to sections of the cited art were appended to the end of claimed features rejected in the Office Action, along with occasional terms and brief discussion, sufficient reasoning was not provided (and sometimes no reasoning was present at all) for many of the claimed features. Further, the Office Action does not indicate which specific features recited in the claims are believed to be taught by which sections of the cited art. For example, while “*template match*” was cited as allegedly corresponding with the claimed “receiving” features, the Office Action does not specify what, if any, specific parts of the cited art are alleged to teach, for example, “receiving at execution time”, “a first and second data processing cell specification”, etc. A rejection without proper reasoning is inadequate since an Office Action lacking proper reasoning does not reasonably put the reader on notice as to **why** the Examiner rejected the claimed features. Rather, the reader is left to draw his or her own conclusions as to why the claims were rejected and accordingly, the burden has not been properly shifted to Appellants. Because the 35 U.S.C. § 103(a) rejection in the Office Action lacks a clear articulation of the reasons why the features recited in the claims would allegedly have been obvious in light of the cited art, the rejection cannot be supported per the requirements set forth by the United States Supreme Court and the Office Action is deficient.

Also, certain features do not appear to have been addressed at all. For example, the Office Action provided the following with respect to the rejection of claim 1: “generating one or more execution flow descriptions (e.g. *result tree* - sec 7, pg. 26-42; template which can be instantiated into a *result tree* - sec 1 Introduction, page 4)”. However, the features “describing

the execution order of said plurality of statements of said first data processing cell specification based on results of the determination” were then included without any citation. Thus, the Office Action has not provided any indication as to where these features are allegedly found in the cited art, let alone provided reasoning for the rejection of these features. Accordingly, the Office Action is not “complete as to all matters” as required by 37 C.F.R. § 1.104(b).

The Advisory Action alleged on page 2 that “claim language about unnested first and second cell ... with order processing requiring a formula to be evaluated has been addressed, matched, rebutted and counter-rebutted at length throughout the history of the prosecution”. However, assuming *arguendo* that this were the case, no such discussion is present in the rejection of claim 1, for instance. The Office Action **itself** must be complete as to all matters and must be capable of standing alone, and any previous discussion would not cure the deficiencies of the outstanding Office Action. Further, Appellants found nothing in the history of this case that adequately explains the rejections for all of the claimed features.

With respect to the Advisory Action’s allegation on page 2 that “‘documenting’ as recited in the claim has been given no particular weight in view of a lack of enablement (see precedence of record, i.e. USC 112 1st para) regarding which no clear remedying from the Applicants has been able to overcome”, Appellants find this language to be curious given that the word “documenting” is not found anywhere in the claims. Rather, the mention of “documenting” appears to be directed to the present specification. Further, there was no 35 U.S.C. § 112, first paragraph, rejection for an alleged lack of enablement in the outstanding Office Action. Accordingly, this allegation is clearly erroneous.

The Advisory Action also alleged on page 2 that “In all, the arguments are not exactly fulfilling a CFR 111b requirement which requires proper explanation for each element of the claim terms and how it would clearly distinguish over a cited portion of W3C or Renner.” However, this is not what 37 C.F.R. § 111(b) requires. Rather, 37 C.F.R. § 111(b) states that “[t]he reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action and must reply to every ground of objection and rejection in the prior Office action.” In this case, the only ground of rejection of the claims was a rejection under 35 U.S.C. § 103(a), to which Appellants replied at length in the previous Response filed August 31, 2009. Further, in light of the Office Action’s failure to present a *prima facie* case of obviousness and the fact that the Office Action is not complete as to all matters, the burden of replying to the rejection in any manner besides pointing out the deficiencies of the Office Action did not pass to Appellants. However, in the

interest of expediting prosecution in this case, Appellants did present arguments against the cited art on pages 11-16 of the previous Response, so in any case, the allegation that the previous Response is not in compliance with 37 C.F.R. § 1.111(b) is clearly erroneous.

The Cited Art Clearly Fails to Teach or Suggest Generating Execution Flow Descriptions based on Interaction or Computation References between Data Processing Cells, as Claimed

Independent claim 1 recites, in part, generating execution flow descriptions based on interaction or computation references between data processing cells. As discussed with respect to some embodiments of the present invention with respect to Fig. 1, “a[n] x-sheet execution analyzer 122 is also advantageously provided to analyze the x-sheets 102, in particular, **determining the execution flow of their x-cells** 104, ‘documenting’ the flows in execution flow descriptions 132. Further, a[n] x-sheet execution engine 124 is provided to execute the x-cells 104 in accordance with the determined execution flow” (see, for example, page 5, lines 15-19, of the present specification, emphasis added). “Upon locating the next x-cell, analyzer 122 would determine if the located x-cell **references other x-cells**, either by way of the ‘use’ attribute, or by virtue of its formulas, block 204” (see, for example, page 14, lines 12-14, of the present specification, emphasis added). “[T]he cumulated interdependency information [is] ordered, block 210, and then output as **execution flow** 132, block 212” (see, for example, page 15, lines 1 and 2, emphasis added). Thus, as discussed in the specification and as claimed, interaction or computation references between data processing cells are determined and then these references are used to generate execution flow descriptions. This differs from XSLT, which merely searches for patterns in nodes in a source tree and applies templates thereto, in essence performing a “find-and-replace” operation. XSLT is completely silent as to determining an execution flow where interdependencies exist among cells. Further, nothing is cited or found in XPath (not actually applied in rejecting claim 1) or Renner et al. that overcomes these deficiencies of XSLT.

Appellants also note that the Office Action’s interpretation on page 10 is not permissible in light of the claims and specification. The Office Action alleged on page 10 that “[t]he language recited as ‘based on a reference to the second data processing cell in the formula that requires computation of the second data processing cell to evaluate the formula’ has been interpreted independent of the proffered ‘flow descriptors’ in the Specifications [sic], and is deemed matched by W3C cell specifications context (refer to more detailed explanation in the Rejection [no such detailed explanation actually present]) implicating the formula value-of select

and the references or parameters found in parsing the formula.” However, as recited in claim 1, one or more **execution flow descriptions** describing the execution order of the plurality of statements of the first data processing cell specification are generated based on results of the determination. This “determination” clearly refers to determining the execution order of the plurality of statements specified by the first data processing cell specification based at least in part on interaction or computation references between the first and second data processing cells. Thus, generating an execution flow is based at least in part on interaction or computation references between data processing cells, as explicitly recited in the claims and the interaction or computation references cannot be interpreted separately, as the Office Action alleges. Appellants note that execution flow descriptors are notably absent from XSLT.

Conclusion

For at least the reasons presented above, it is respectfully submitted that every rejection under 35 U.S.C. § 103(a), the sole ground of rejection presented in the outstanding Office Action, contains clear error. Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, Appellants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

/Michael A. Leonard II/
Michael A. Leonard II
Attorney for Appellants
Registration No. 60,180

Customer No. 74739
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Vienna, Virginia 22182-6212
Telephone: 703-720-7800
Fax: 703-720-7802

MAL:jf
Enclosures: PTO/SB/33 Form
Notice of Appeal